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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,073	02/04/2004	Reynolds E. Moulton III	DGP-005	4526
7590	05/22/2006		EXAMINER	
David J. Rikkers, Esq. Brown Rudnick Berlack Israels LLP One Financial Center Boston, MA 02111			NGUYEN, SONT	
			ART UNIT	PAPER NUMBER
				3643

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/772,073	MOULTON, REYNOLDS E.
	Examiner Son T. Nguyen	Art Unit 3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 April 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 13,23 and 32-37 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12,14-22,24-31 and 38-47 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 February 2004 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

SON T. NGUYEN
PRIMARY EXAMINER

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/10/04 & 5/12/05.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. Applicant's election without traverse of group I, species II, in the reply filed on 4/24/06 is acknowledged. Claims 13,23,32-37 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group I, species II, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 4/24/06.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 14 & 24** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The pet attractant being located outside the housing was not described in the specification. Page 6, lines 10-11, states "For example, the attractant 230 could be loose within the housing or affixed to the housing by an adhesive, a staple or other fastener", which does not state that mounting is to be exist on the outside of the housing. One reading this excerpt would interpret that the attractant is affixed to the inside of the housing instead of to the outside because the excerpt states that the attractant could be loose within the housing or affixed to the housing (meaning to the inner wall or the like).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claim 6** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Line 2, the phrase "said chassis" lacks prior antecedent basis.

Claim Objections

6. **Claims 14 & 24** are objected to because of the following informalities: the two claims are repeat of each other. Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 38-41,43,45-47** are rejected under 35 U.S.C. 102(b) as being anticipated by Markowitz (5765508).

For claim 38, Markowitz teaches a pet toy comprising a housing 4 configured in the shape of an animal; and a drive unit 14,16,18,20 coupled to the housing and adapted to move the housing, the drive unit configured to be provided with energy by moving the drive unit in a direction opposite from a first direction of travel of the housing.

For claim 39, Markowitz teaches wherein the drive unit is provided with energy directed through at least one wheel, the drive unit configured to propel the pet toy in the first direction by turning the at least one wheel.

For claim 40, Markowitz teaches wherein the housing is configured in the shape of a mouse 1.

For claim 41, Markowitz teaches a tail 6, mounted to said housing and located on a rearward-facing portion of said housing.

For claim 43, Markowitz teaches a pet toy, comprising: a chassis 2; a drive unit 14,16,18,20 coupled to the housing and adapted to move the chassis, the drive unit configured to be provided with energy by moving the drive unit in a direction opposite from a first direction of travel of said chassis; and a housing 4 coupled to the chassis, wherein the housing is configured in the shape of an animal.

For claim 45, Markowitz teaches wherein the energy is directed through at least one wheel 20, propelling the pet toy in the first direction.

For claim 46, Markowitz teaches wherein the housing is configured in the shape of a mouse.

For claim 47, Markowitz teaches a tail 6, mounted to said housing and located on a rearward-facing portion of said housing.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1-4,6-11,14-22,24-25,27-31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz (as above) in view of Tsengas (6571742).

For claims 1 & 4, Markowitz teaches a pet toy, comprising: a housing 4; a drive unit 14,16,18,20 coupled to the housing and adapted to move the housing. However, Markowitz lacks a pet attractant coupled to the housing. Tsengas teaches the same field of endeavor of pet toy in which he places a pet attractant such as catnip (col. 5, line 45) in the toy to further entice the pet to play with the toy. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ catnip as taught by Tsengas in the toy of Markowitz in order to further entice the pet to play with the toy.

For claim 2, Markowitz as modified by Tsengas (emphasis on Markowitz) teaches wherein the housing is configured in the shape of an animal.

For claim 3, Markowitz as modified by Tsengas (emphasis on Markowitz) teaches wherein the housing is configured in the shape of a mouse.

For claim 6, Markowitz as modified by Tsengas (emphasis on Markowitz) teaches wherein the drive unit is provided with energy by moving the drive unit in a direction opposite from a first direction of travel of said chassis.

For claim 7, Markowitz as modified by Tsengas (emphasis on Markowitz) teaches wherein the energy is directed through at least one wheel 20, propelling the pet toy in the first direction.

For claim 8, Markowitz as modified by Tsengas (emphasis on Markowitz) teaches an outer layer, mounted on said housing, to provide a fur-like appearance (col. 4, line 5).

For claim 9, Markowitz as modified by Tsengas (emphasis on Markowitz) teaches at least one facial component, mounted on a forward-facing portion of said housing.

For claim 10, Markowitz as modified by Tsengas (emphasis on Markowitz) teaches the at least one facial component including an eye, a nose and an ear.

For claim 11, Markowitz as modified by Tsengas (emphasis on Markowitz) teaches a tail 6, mounted to said housing and located on a rearward-facing portion of said housing.

For claim 14, Markowitz as modified by Tsengas lacks wherein the pet attractant is located outside the housing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the pet attractant on the outside of the housing of Markowitz as modified by Tsengas, depending on the user's preference to further entice the pet.

For claims 15-22,24-25,27-28, Markowitz as modified by Tsengas teaches the claimed limitation in the above.

For claim 29, Markowitz as modified by Tsengas (emphasis on Markowitz) further teaches a ballast. Note, the nuts and bolts to fasten parts together in Markowitz are considered to be ballasts since Applicant discloses that the ballast can be the nuts or bolts. Also, the batteries 10 of Markowitz can be considered ballasts too.

For claims 30-31, Markowitz as modified by Tsengas (emphasis on Markowitz) further teaches at least one biased gear, an axle and a wheel, wherein the gear and axle are rotated by the biased gear. Note, these components are all inherent in

Markowitz's teaching because he teaches motor, axle, wheels, gearbox to contain all the gears, etc.

11. **Claims 5 & 26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz as modified by Tsengas as applied to claim 1 above, and further in view of Morikawa (5638922).

Markowitz as modified by Tsengas lacks the drive unit being a pull-back spring drive. Morikawa teaches the same field of endeavor of toy in which he employs a pull-back spring drive as a drive source for the toy. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a pull-back spring drive as taught by Morikawa as the preferred drive unit in Markowitz as modified by Tsengas in order to provide a better drive source for the toy which provides power to all four wheels of the toy.

12. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz as modified by Tsengas as applied to claim 1 above, and further in view of Bartleson (5653196).

Markowitz as modified by Tsengas lacks the pet attractant being located in a storage unit coupled to the housing. Bartleson teaches the same field of endeavor of pet toy in which Bartleson places catnip in a storage unit 6 and placed the unit in the housing or toy 1 so as to prevent the catnip from spilling everywhere. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the catnip of Markowitz as modified by Tsengas in a storage unit as taught by

Bartleson coupled or placed inside to the housing in order to prevent the catnip from spilling everywhere.

13. **Claims 42 & 44** are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz (as above) in view of Morikawa (as above).

Markowitz lacks the drive unit being a pull-back spring drive. Morikawa teaches the same field of endeavor of toy in which he employs a pull-back spring drive as a drive source for the toy. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a pull-back spring drive as taught by Morikawa as the preferred drive unit in Markowitz in order to provide a better drive source for the toy which provides power to all four wheels of the toy.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is 571-272-6889. The examiner can normally be reached on Mon-Thu from 10:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Son T. Nguyen
Primary Examiner
Art Unit 3643

stn